

Notice of Allowability

Application No.

09/612,945

Examiner

Robert M. Pond

Applicant(s)

TSUNENARI, TOMOO

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE filed 27 December 2005 and Examiner's Amendment Paper #20060301.
2. ☒ The allowed claim(s) is/are 1-27.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 7/13/01; 1/17/02
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20060303; 20060306.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization

Authorization for this examiner's amendment was given in a telephone interview with Mr. Michael Sandonato, Registration #35,345 on 03 March 2006.

Claims Allowable

Claims 1-27 are allowed. No claims were canceled. No claims were withdrawn.

In the Claims

The claims entered on 27 December 2005 have been amended as follows:

- Delete all of claim 1 in its entirety and insert therefore:
 - -1. A computer, located on a network, for effecting the return of a consumer product for recycling, the computer comprising:
 - (a) hardware operating under the control of software that receives from another computer located on the network consumer information which

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includes an identification of a consumer product to be returned for recycling and a present location of the consumer product;

(b) hardware operating under the control of software that automatically determines a destination for the consumer product, based upon the received identity of the consumer product and the received present location of the consumer product;

(c) hardware operating under the control of software that automatically determines a carrier service that will deliver the consumer product to the destination based upon the received present location of the consumer product and the location of the automatically determined destination; and

(d) hardware operating under the control of software that transmits to the other computer shipping label data which includes an identification of the automatically determined destination and an identification of the automatically determined carrier service.- -

- Delete all of claim 2 in its entirety and insert therefore:

- -2. The computer of claim 1, further comprising the hardware operating under the control of software that stores consumer information received from the other computer in a database server.- -

- Delete all of claim 4 in its entirety and insert therefore:

- -4. The computer of claim 2, wherein the consumer information includes consumer name and address information.- -

- In claim 9, line 2, delete "operably" and insert therefore: - -operatively- -

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- Delete all of claim 15 in its entirety and insert therefore:

- -15. A first computer operatively connected to a printer, said first computer located on a network linking said first computer with a second computer, the first computer comprising:

(a) hardware operating under the control of software that transmits to a second computer consumer information including at least product type information and present location information for a consumer product to be returned for recycling;

(b) hardware operating under the control of software that receives from the second computer shipping label data including an identification of an automatically determined destination for the consumer product and an identification of an automatically determined carrier service that will deliver the consumer product to the destination, the destination having been automatically determined by the second computer based upon the received product type information and the received present location of the consumer product, and the carrier service having been automatically determined by the second computer based upon the received present location of the consumer product and the location of the automatically determined destination; and

(c) hardware operating under the control of software that transmits the shipping label data to the printer to enable the printer to print a shipping label.- -

- Delete all of claim 16 in its entirety and insert therefore:

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- -16. A system for effecting return of a consumer product for recycling, comprising:

- (a) a first computer;
- (b) a second computer;
- (c) a network linking the first computer to the second computer, the second computer receiving consumer information from said first computer over the network and to transmit shipping label data to said first computer, said consumer information including an identification of a consumer product to be returned for recycling and a present location of the consumer product, said shipping label data including an automatically determined destination for the consumer product and an identification of an automatically determined carrier service that will deliver the consumer product to the destination, the destination having been automatically determined by the second computer based upon the received identity of the consumer product and the received present location of the consumer product, and the carrier service having been automatically determined by the second computer based upon the received present location of the consumer product and the location of the automatically determined destination; and
- (d) a printer operatively connected to said first computer that prints a shipping label from the shipping label data.- -

- Delete all of claim 17 in its entirety and insert therefore:

- -17. The system of claim 16, further comprising a consumer information database server that stores consumer information.- -

In the Specification

The specification as amended on 05 March 2004 has been amended as follows: Page 15, line 19, after "or the like," insert Therefore: - -The user enters the information and clicks on the submit button 81.- -

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The Applicant's invention is directed to a system and method that utilizes computers and an electronic network to effect the return of products to a recycling facility.

Computer claims 1 and 15, system claim 16, method claim 10, and computer program product claim 23: Upon receiving consumer information over a network from a client computer, the client computer receives shipping label data from a network server that includes the carrier that was automatically determined based upon present location of the product destined for recycling and the automatically determined recycling destination.

In an onsite interview held on 19 December 2005, the Examiner and his Supervisor found arguments to patentability provided by Mr. Sandonato as being persuasive as applying to this case and copending CIP 09/792,646. The

interview summary was filed only under 09/792,646. With this Notice of Allowability, the Examiner is correcting the record for this case by including an interview summary for the record to reflect similar outcome for this instant case.

The Examiner's arguments supporting the combination of USPS in view of WorldSpy are withdrawn as a consequence of the onsite interview. It was determined that USPS does not provide a motivation to combine with WorldSpy nor does WorldSpy motivate one of ordinary skill in the art to modify USPS to achieve the claimed instant invention. Neither USPS nor WorldSpy alone or in combination with each other teach every claim limitation of the instant invention.

Non-patent prior art

USPS teaches a traditional method of a returning product to a merchant. USPS's Returns@ease is designed to facilitate product returns to a merchant by a merchant's customer (i.e. a customer can return a product if the product was purchased from the merchant). USPS teaches Returns@ease being operated by the United States Postal Service. There is no automatic determination of a carrier service based on the product's present location and location of the automatically determined destination. The carrier is pre-determined to be USPS.

The prosecution record is clear regarding the type of product being returned. As claimed and argued by the Applicant the returned product is being returned for recycling (e.g. recyclable toner cartridge). The Applicant's claimed invention automatically determines a carrier based on the present location of the product to be recycled. In contrast, USPS further teaches a pre-printed return shipping label

being included with the customer's toner cartridge shipment and, upon returning, the customer affixing the pre-printed return shipping label to the package and leaving it for the UPS driver (i.e. United Parcel Service driver) to pick up. As with the USPS's Returns@ease system, the carrier is pre-determined. There is no automatic determination of a carrier service and there is no automatic determination of a recycling destination, both of which are based on data supplied by the customer desiring to return the product for recycling. While the teachings of WorldSpy address product returns, it does so in a similar method of returning goods to the manufacture or a warehouse. Neither of these destinations is disclosed as being a recycling facility nor is the carrier service automatically determined based upon the automatic determination of the recycling destination and present location of the product.

US Patent and US Patent Publication prior art

Junger (US 6,085,172) was previously cited and withdrawn due to persuasive arguments from the Applicant. Junger deals with the process of returning product but suffers from deficiencies similar to USPS and WorldSpy. Junger fails to teach automatic determination of a carrier service based on present product location and fails to disclose returning a recyclable product. Junger specifically evaluates a returned product's warranty status and bases approval upon warranty status. Junger teaches denying approval due to warranty status having expired. It is the Examiner's opinion that a product being returned for recycling such as depleted

toner cartridge would not be approved for return for having served its intended purpose as a consumable (i.e. warranty expired).

Suzuki (US 5,965,858) was referenced in the Applicant's instant specification. Suzuki teaches recycling returned products, a carrier service transporting returned product, and a customer using a delivery service to send a discarded article to the recycling factory, but suffers similar deficiencies as USPS, WorldSpy, and Junger. Suzuki fails to teach automatic determination of a carrier service based upon present location of the product and the automatically determined recycling facility.

Foreign Publication prior art

Jenkins et al. (IDS filed 17 January 2002, WO 95/26004) teaches purchase/return transactions but fails to anticipate or render the claimed invention obvious.

The prior of record neither anticipates nor teaches and suggests claim 1, 10, 15, 16, and 23.

Conclusion

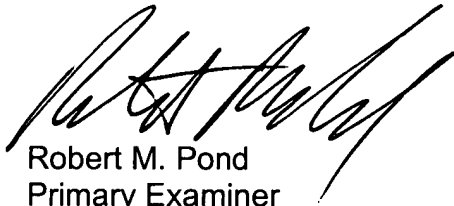
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is written over the printed name.

Robert M. Pond
Primary Examiner
March 6, 2006